

REMARKS / ARGUMENTS

The present application includes pending claims 1-76. Claims 1-11, 14-38, 40, and 42 have been rejected. Claims 12, 13, 39, and 41 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. By this Amendment, claims 43-76 have been added and claims 1-2, 4-7, 20, and 30-31 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 8-11, 14-15, 19-20, 31-38, 40, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,576, issued to Gurantz, et al. (hereinafter, Gurantz), in view of U.S. Patent No. 7,123,875, issued to Marko, et al. (hereinafter, Marko). Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gurantz, in view of Marko, further in view of U.S. Patent No. 6,256,493, issued to Dorenbosch, et al. (hereinafter, Dorenbosch). Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gurantz, in view of Marko and Dorenbosch, further in view of U.S. Patent No. 5,384,847, issued to Hendrickson, et al. (hereinafter, Hendrickson). Claims 16-18, 21-27, and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gurantz, in view of Marko, further in view of U.S. Patent No. 6,445,907, issued to Middeke, et al. (hereinafter, Middeke). Claim 28 stands rejected under

35 U.S.C. § 103(a) as being unpatentable over Gurantz, in view of Marko, further in view of U.S. Patent Application Publication No. 2001/0024962, issued to Bauer (hereinafter, Bauer). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art

cannot be relied upon to provide the suggestion...," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Gurantz and Marko Does Not Render Claims 1-3, 8-11, 14-15, 19-20, 31-38, 40, and 42 Unpatentable

The Applicant first turns to the rejection of claims 1-3, 8-11, 14, 15, 19-20, 31-38, 40, and 42 as being unpatentable over Gurantz in view of Marko.

A. Independent Claims 1 and 31

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Gurantz and Marko does not disclose or suggest at least the limitation of "at least one processor integrated within said single integrated circuit chip and coupled to said first satellite receiver demodulator and said second satellite receiver demodulator, wherein **said at least one processor generates separate encoded audio and video streams based on at least one demodulated signal received from said first satellite receiver**

demodulator and/or said at least said second satellite receiver demodulator,"
as recited by the Applicant in independent claim 1 (emphasis added). The Office
Action states the following:

As to claims 1, 31, 42, Gurantz teaches a system for an integrated set-top box, the system comprising: a first satellite receiver demodulator (see fig. 12, col. 10, lines 19-26); at least a second satellite receiver demodulator (see fig. 12, col. 10, lines 19-26); and at least one processor (see fig. 12, col. 10, lines 19-26). Gurantz fails to teach wherein the receivers are integrated within the single integrated circuit chip.

See the Office Action at page 2. The Applicant respectfully disagrees with the
above argument, which relies on Figure 12 and the following citation of Gurantz:

Referring to FIG. 12, signal selector and combiner 1210 taps the signals output from each LNB to provide the transponder selection function. Switch 1220 is under control of the signal selector and combiner 1210. Switch 1220 will be actuated to supply either a conventional signal from multipoint switch 1260 or the composite transponder signal from signal selector and combiner 1210. Switch 1220 can be a solid-state device or electromechanical relay.

See Gurantz, col. 10, lines 19-26. The Applicant points out that **Gurantz, including col. 10, lines 19-26, does not disclose a first and a second satellite receiver demodulators, as well as a processor coupled to the demodulators, that generates separate encoded audio and video streams.** At the above citation (col. 10, lines 19-26), Gurantz discloses the communication of conventional signals, via the multipoint switch 1260, or composite transponder signals, via the signal selector and combiner 1210, to the three separate set-top

boxes (STB). Furthermore, **Gurantz does not disclose or suggest a first satellite receiver demodulator, at least a second satellite receiver demodulator and at least one processor are integrated within a single integrated circuit chip**, as recited by the Applicant in claim 1. The Examiner also concedes at page 2 of the Office Action that "Gurantz fails to teach wherein the receivers are integrated within the single integrated circuit chip."

The Examiner then seeks support in Marko and states the following:

Marko teaches wherein the receivers are integrated within the single integrated circuit chip (see fig. 4, numbers 302, 304, col. 4, lines 47-63, col. 6, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Marko into the system of Marko in order to provide significant cost and space/area savings.

See id. Initially, the Applicant points out that **Marko relates to the art of satellite digital audio radio services (SDARS), where only satellite audio signals are being processed**. Marko does not, on its face, relate to satellite receivers, including satellite receiver demodulators, which receive and demodulate audio and video signals. Therefore, **Gurantz and Marko may not be properly combined** for purposes of a rejection under 35 U.S.C. § 103(a).

Referring to Figure 4 of Marko, the satellite digital audio radio service (SDARS) receiver 20' uses a channel decoder block 300. The channel decoder 300 receives the IF signal from the terrestrial repeater 16, demodulates it via the demodulator 306 and decodes it via the decoding management block 308. Even though Marko discloses that the channel decoder block 300 may use satellite

demodulators 302 and 304, **Marko does not disclose that the two satellite demodulators 302 and 304 are integrated together with a processor in a single integrated circuit chip, where the processor generates separate encoded audio and video streams.** In fact, Marko discloses that the two satellite demodulators are not used by the disclosed implementation of the receiver 20'.

Therefore, the proposed combination of Gurantz and Marko does not disclose or suggest "at least one processor integrated within said single integrated circuit chip and coupled to said first satellite receiver demodulator and said second satellite receiver demodulator, wherein said at least one processor generates separate encoded audio and video streams based on at least one demodulated signal received from said first satellite receiver demodulator and/or said at least said second satellite receiver demodulator," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Gurantz and Marko does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claim 31 is similar in many respects to the system disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 31 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

Accordingly, the proposed combination of Gurantz and Marko does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness

has not been established. The Applicant submits that claim 1 is allowable. Independent claim 31 is similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 31 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-3, 8-11, 14-15, 19-20, 32-38, 40, and 42

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Gurantz in view of Marko has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-3, 8-11, 14-15, 19-20, 32-38, 40, and 42 depend from independent claims 1 and 31, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-3, 8-11, 14-15, 19-20, 32-38, 40, and 42.

II. The Proposed Combination of Gurantz, Marko, and Dorenbosch Does Not Render Claims 4-6 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gurantz in view of Marko has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Dorenbosch) does not overcome the deficiencies of Gurantz and Marko, claims 4-6 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4-6.

III. The Proposed Combination of Gurantz, Marko, Dorenbosch, and Hendrickson Does Not Render Claim 7 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gurantz in view of Marko has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited references (Dorenbosch and Hendrickson) does not overcome the deficiencies of Gurantz and Marko, claim 7 depends from independent claim 1, and is, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim

1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 7.

IV. The Proposed Combination of Gurantz, Marko, and Middeke Does Not Render Claims 16-18, 21-27, and 29-30 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gurantz in view of Marko has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Middelke) does not overcome the deficiencies of Gurantz and Marko, claims 16-18, 21-27, and 29-30 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 16-18, 21-27, and 29-30.

V. The Proposed Combination of Gurantz, Marko, and Bauer Does Not Render Claim 28 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gurantz in view of Marko has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Bauer) does not overcome the

deficiencies of Gurantz and Marko, claim 28 depends from independent claim 1, and is, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 28.

VI. ALLOWABLE SUBJECT MATTER

Claims 12, 13, 39, and 41 were objected to as being dependent on a base claim, but would be allowable if rewritten in independent form. By this Amendment, new claims 43-76 have been added. New independent claim 43 corresponds to claim 12. New dependent claim 44 corresponds to claim 13. New independent claim 63 corresponds to claim 31. New independent claim 70 corresponds to claim 41.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-76 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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